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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 32

Application Number: 09/240,524

Filing Date: 1/29/1999

Appellant(s): Gerndt et al.

Eric T. Krischke

For Appellant

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EXAMINER'S ANSWER

This is in response to the appeal brief filed 8/22/2002.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The rejection of claims 1-25 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

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(8) *ClaimsAppealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

5,292,298	Scannell	3-1994
4,658,486	Schonemann	4-1987
5,887,644	Akiyoshi et al.	3-1999
5,899,264	Marschke	5-1999

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35

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U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-25 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Scannell in view of Schonemann or Akiyoshi et al. or Marschke.

The patent of Scannell in Figures 1-3 and 5 discloses all the claimed features with the exception of the passage extending between the inlet and outlet ends of the roller.

The patents of Schonemann, Akiyoshi et al. and Marschke disclose that it is known to have a passage between the inlet and outlet ends of a roller for the purpose of saving space and manufacturing costs (i.e. using less tubing in the plumbing of the fluid supply and removal system) by delivering and removing a fluid to and from only one end of the roller. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to employ in Scannell the passage between the inlet and outlet ends of the roller for the purpose of saving space and manufacturing costs by delivering and removing the fluid to and from only one end of the roller as disclosed in Schonemann, Akiyoshi et al. and Marschke. The claimed number of channels is considered to be an obvious design choice which does not solve any stated problem or produce any new and/or unexpected result. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have two rollers, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8. Also, Akiyoshi et al. teaches two rollers.

(11) Response to Argument

Appellant's concerns directed toward the references not teaching a plurality of inlet channels are not found persuasive. Clearly, Scannell, in at least figures 2 and 5-6; in column 4,

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lines 41-61 and in column 5, lines 53-61, discloses a heat transfer roll (10) having a plurality of inlet channels (areas/flow passages between flow spacers/walls 74a-74f illustrated in figure 5) in an inlet chamber (area between plates 70,72 in figure 6), each channel has a first end closer to a passage (80 in figure 5) and a second end closer to an annulus (area/flow passage between plates (12',14' in figure 6 and plates 12, 18 in figure 2), wherein each inlet channel becomes progressively wider (see areas/flow passages between flow spacers/walls 74a-74f illustrated in figure 5) between the first and second ends and the walls 74a-74f are illustrated in Scannell as being substantially uniform in thickness. The outer channels and outlet chamber are identical to the inlet channels and outlet as stated in column 4, lines 56-61 in Scannell.

Regarding appellant's concerns directed toward the motivation of combining the references, the fact that appellant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). Also, there is not requirement that the motivation for combining references be the same reason that applicant has given. See *In re Dillon*, 16 USPQ 2d 1897. The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves **or in the knowledge generally available to one of ordinary skill in the art**. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the documents of Schonemann in at least figures 2 and 4-5, Akiyoshi et al. in at least figure 1, and

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Marschke in figures 2, 6 and 9-10 disclose that it is known to have a passage between the inlet and outlet ends of a roller for the purpose of saving space and manufacturing costs (i.e. using less tubing in the plumbing of the fluid supply and removal system) by delivering and removing a fluid to and from only one end of the roller. The patent of Schonemann, in figures 1-5, even teaches that it is well known in the heat transfer roller art to have two types of "plumbing arrangements". The first type of plumbing arrangement is illustrated in figures 1 and 3 of Schonemann which is the same type of plumbing arrangement disclosed in Scannell which is to have the fluid inlet at one end of the heat transfer roll and the outlet end at the opposite end of the heat transfer roll. The second type of plumbing arrangement is disclosed in figures 2 and 4-5 of Schonemann which to have both the fluid inlet and fluid outlet located at one end of the heat transfer roll for the purpose of making the roll lighter by having a passageway (54 in figure 5) and reducing the duplication of inlet and outlet hardware on both ends of the roll. Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to employ in Scannell the passage between the inlet and outlet ends of the roller for the purpose of saving space, weight and manufacturing costs by delivering and removing the fluid to and from only one end of the roller as disclosed in Schonemann, Akiyoshi et al. and Marschke.

In response to appellant's argument that the references fail to show certain features of appellant's invention, it is noted that the features upon which appellant relies (i.e., "the purpose of preventing spiral flow patterns would be achieved with the intended result of improving the fluid distribution about the annulus") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the

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claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). However, the patent of Scannell, in figures 1 and 2, teaches the annulus (area/flow passage between plates (12',14' in figure 6 and plates 12, 18 in figure 2) having at least one spiral flow channel (see figures 1 and 2 and column 4, lines 5-20 in Scannell) as applicant has claimed in claim 13.

In response to appellant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Scannell, not the devices of Schonemann, Akiyoshi et al. and Marschke, is relied upon in the above rejection, to teach the inlet and outlet flow channels are stated in the first paragraph under the "**Response to Argument**" section above. The teaching of cleaning is capping the passage end. It does not matter if the passage is capped and extends at only one end of the roll or if the passage is capped and extends the entire length of the roll.

In response to appellant's argument directed toward Schonemann, Akiyoshi et al. and Marschke, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). The only teaching taken from teach of the Schonemann, Akiyoshi et al. and Marschke is that it is known to have a passage between the inlet and outlet ends of a roller for the purpose of saving space and manufacturing

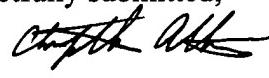
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costs (i.e. using less tubing in the plumbing of the fluid supply and removal system) by delivering and removing a fluid to and from only one end of the roller. Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to employ in Scannell the passage between the inlet and outlet ends of the roller for the purpose of saving space and manufacturing costs by delivering and removing the fluid to and from only one end of the roller as taught in each of Schonemann, Akiyoshi et al. and Marschke.

In response to appellant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the appellant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). The Examiner used references (i.e. the devices of Schonemann, Akiyoshi et al. and Marschke), not applicant's disclosure, to teach that it is known to have the fluid inlet and fluid outlet at one end of a heat exchanger roll as stated in the above rejection.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

C.A. 
C.A.

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November 4, 2002

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